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09/855,042	05/14/2001	David A. Solin	1220	8654

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EXAMINER

ROBINSON, GRETA LEE

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,042

Applicant(s)

SOLIN, DAVID A.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 15-18 is/are allowed.
6) ☒ Claim(s) 1-14 and 19-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 3, 2004 has been entered.

2. Claims 1-21 are pending in the present application. Claims 1, 3, 8, 10 and 15 have been amended.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5-7, 12-14 and 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 5-7, 12-14 and 19-21 the limitation "occasion" does not appear to be described in the disclosure. The disclosure does not appear to describe a "first occasion" or a "second occasion" as cited in the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-14 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujita (US Patent 5,386,553).

Regarding claim 1, **Fujita** teaches a method of updating a computer system

[note: "updating instructions" s10, figure 8], the method comprising:

receiving a first set of update information, the first update information having a size [note: col. 4 lines 62-68];

requesting a second set of update information responsive to at least the size of the first set of update information [col. 4 line 68 through col. 5 line 11; figure 3 note "amount of data information" 10] ; and

updating the computer system responsive to one selected from: the first set of update information received; and the first set of update information received and the second set of update information requested [see: abstract; figure 8 note updating; col. 2

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line 53 through col. 3 line 31; col. 3 line 32-52; col. 6 lines 20-27; col. 9 line 42 through col. 10 line 23].

Fujita teaches file updating in which the type of updating is responsive to the amount of data or file size.

7. Regarding claims 2 and 4:

(claim 2) wherein the updating step comprises deleting at least one set of information, said at least one set of information stored on the computer system prior to the receiving step, responsive to the first set of update information received [col. 8 lines 30-62; col. 7 lines 19-25].

(claim 4) wherein the requesting step is additionally responsive to a size of an area into which information may be stored [abstract; figure 3 note "amount-of-data information" (10); col. Col. 3 lines 45-52 "changing a size of the disk file according to the type of updating operation to be performed and the amount of data represented by the amount-of-data information"].

8. Regarding claim 3:

receiving at least one third set of update information ... a difference in times between a performance of each of the receiving the third set of update information and the updating [note: Fujita teaches predetermined timing see col. 7 lines 25-35].

9. Regarding claims 5-7:

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requesting on a first occasion a first set of update information for a first set of information responsive to a list comprising at least one identifier of the first set of information ... modifying the first set of information responsive to the first set of update information received ... [note: col. 2 lines 24-30; col. 2 line 53 through col. 3 line 31; col. 5 lines 12-35; col. 7 lines 19-25].

10. The limitations of computer program product claims 8-14 and system claims 19-21 parallel method claims 1-7; therefore they are rejected under the same rationale.

Allowable Subject Matter

11. Claims 15-18 are allowed. Fujita and the prior art of record fails to teach a holding area manager and an installer/deleter as cited in independent claim 15.

Response to Arguments

12. Applicant's arguments filed May 3, 2004 have been fully considered but they are not persuasive.

In the response Applicant argued the following: (1) the term "occasion" has a dictionary definition consistent with the specification. It may be thought of as including "at a first time" and "a second time". Applicant argues that term is supported in the specification. (2) Fujita does not request a second set of update information based on the size of a first set of update information.

In response to Applicant's arguments above, the examiner notes that the term "occasion" is not used in the disclosure, only in the claims. Applicant has not pointed out by page and line number support for the limitation in the disclosure; therefore note new rejection supra. Fujita does address updating files as claimed. Fujita teaches updating information based on the amount of information note col. 2 lines 58-63, also note col. 5 lines 8-11. Applicant's response overcomes the rejection of independent claim 15, note allowable subject matter supra.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mortis et al. US Patent 5,832,509

Namba US Patent 6,314,418 B1

Huang et al. US Patent 6,611,835 B1

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GRETA ROBINSON
PRIMARY EXAMINER

Greta Robinson
Primary Examiner
June 1, 2004